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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,788	09/23/2004	Nobuyuki Masumura	2004_1509A	3936
513 7590 09/13/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER PILKINGTON, JAMES	
			ART UNIT 3682	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/508,788	<b>Applicant(s)</b> MASUMURA ET AL.	
	<b>Examiner</b> James Pilkington	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 and 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 8/2/07 for a Continued Examination (RCE) is accepted and a RCE has been established. An action on the RCE follows.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-26 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All claims now recite a "stretch-oriented" fibrous member. Nowhere in the specification is there disclosure of a "stretched-oriented" fibrous member. What is a "stretch-oriented" fibrous member? Page 12 lines 3-9, cited by the applicant, only states that the stretching changes the orientation of the fibrous, there is no disclosed meaning for the term "stretch-oriented," see below.

Regarding claim 33, no support in the specification for "the same family" of resin to mean that the resins comprise "identical resins or including principal components of identical resins." The original specification does not provide support for this limitation. No mention of what constitutes a material being "in the same family" was made in the

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original specification nor what having the materials coming from "the same family" allows for as argued on page 6 of the remarks.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17-26 and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner does not understand what is meant by the term "stretched-oriented." What is the direction that corresponds to a stretched orientation? Is "stretched-oriented" mean that the fibrous member is arranged along the direction that the belt would stretch in a system? If so, doesn't this then repeat the limitation "extending along each of said longitudinal edges"?

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17-26 and 33, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al, EP 1083347 A2 (published March 14, 2001).

Matsumoto discloses a belt for a ball chain comprising;

- a tape (21, Figure 7 and 8) of synthetic resin (C2/L52-53)

- extending along longitudinal edges and integral with the tape are stretch-oriented monofilament fibrous member (23, C7/L38-55) of thermoplastic resin (Matsumoto discloses synthetic resin C7/L38-55) and wherein each of the stretched fibrous members are positioned inwardly of the corresponding edge (Figure 8 shows that stretched member 23 is inward of the edge of the belt)
- ball inseting holes (20) spaced at equal intervals along a straight line (spaced apart by projections 22) between the longitudinal edges
- projections (22) disposed around the holes
- both resins are in the same family by virtue of comprising principal components of identical resins (both resins can have carbon)

#### ***Response to Arguments***

8. Applicant's arguments filed 7/9/07 have been fully considered but they are not persuasive.
9. The applicant argues that EP '347 does not disclose or suggest reinforcement of a synthetic resin fiber by stretching.

As noted in the prior office action it is the examiner's position that heating and pulling, as disclosed in the prior art reference, does indeed stretch the reinforcing material. The applicant states in the remarks on page 6 starting on line 16 that there is nothing in the prior art to suggest that a sufficient tension will be created by heating and pulling to indeed stretch the material. The applicant further relies on references from the Encyclopedia of Polymer Science and Engineering to disclose a difference between stretching processes. First, the independent claim does not recite anything about the

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tension in the stretched member. The independent claim only requires that the material to be stretched which heating and pulling will indeed do. Second, what determines patentability in an apparatus claim is not the process used to make it but the structural limitations of the claims, see MPEP 2113. Since the claim does not recite any structural difference to distinguish the instant application from the prior art the rejection under 35 USC 102(b) is indeed proper.

10. The applicant argues at the bottom of page 6 that the prior art does not disclose that the resins are from the same family.

In the original filing the term "same family" was not defined to mean that the resins must be identical or have the same principal components as new claim 33 now requires (see above). As broadly recite in the original filing all resins fall under the same family, the family of resin based compounds or materials.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Pilkington whose telephone number is (571) 272-5052. The examiner can normally be reached on Monday-Friday 8:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JP

9/7/07



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SUPERVISORY PATENT EXAMINER